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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,889	05/11/2006	Konrad Tetenborg	P71218US0	5028
136 7590 06/09/2011 JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			EXAMINER HELVEY, PETER N.	
			ART UNIT 3782	PAPER NUMBER
			MAIL DATE 06/09/2011	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/578,889

Applicant(s)

TETENBORG ET AL.

Examiner

PETER HELVEY

Art Unit

3782

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/25/2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 9-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 & 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2011 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's arguments with respect to Warr as used in the restriction requirement are considered but not persuasive for the reasons presented in the Response to Arguments section below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the disclosure does not provide information on how one skilled in the art could construct a line of perforations that changes shape across a heat seal when it only exists on one side of the heat seal.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-8, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Beer et al.* (US 5060803, hereinafter '*Beer*') in view of *Warr* (US 5558438).

Beer discloses a FFS-capable gusset bag comprising a tear-open perforation (46) at least in the area of one of the corners of the bag, wherein the bag comprises a cross-weld seal (40B) in the area of at least one corner.

Beer does not expressly disclose that the forming of the tear-open perforation in the area of at least one corner is changed in such a way that the perforation in the interspace between the edge of the bag and the corner weld seal has a different structure relative to the second perforation between the corner weld seal and the centerline of the bag.

However, *Warr* teaches providing a tear open perforation that changes shape across a heat seal (Fig. 1, 23, 21).

Because *Warr* and *Beer* both teach tear opening perforations for the opening of a pouch, it would have been obvious to one of ordinary skill in the art to substitute the notch and line of perforations taught by *Warr* for the notch taught by *Beer* to achieve the predictable result of opening the pouch.

At the time of the invention, it further would have been obvious to a person having ordinary skill in the art to add the line of perforations taught by *Warr* to the

bag taught by *Beer*, in order to provide an easy opening tear point that follows a more predictable path (col. 4, ll. 15-30).

The examiner notes that the combination above results in a device wherein the length or the periphery of the perforation incision in the interspace between the edge of the bag and the corner weld seal is larger than the length of the perforation incisions between the corner weld seal and the centerline of the bag, clearly also resulting in the opposite as well. Further, the perforations must be smaller than the diameter of the material inside otherwise the bag wouldn't perform the intended function. In addition, because no material is claimed the material could be anything and clearly golf balls would not be capable of passing through any of the perforations in the combination if golf balls were the contents of the bag. The corner weld seal further comprises passages (after tearing is complete, allows pouring of material) and the line of perforations comprises one line.

Beer as modified by *Warr* discloses substantially all the limitations of the claim(s) except for the omission of the perforations between the weld seal and the centerline of the bag. It would have been obvious to one having ordinary skill in the art at the time the invention was made to eliminate a portion of the tear perforation line, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the other top corner with the same weld line and tear open perforations, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

As a note, the examiner has interpreted all product by process and functional limitations in accordance with the MPEP and the combination recited above is considered to meet the scope of the claims.

It should be appreciated that the applicant's functional language in the claims does not serve to impart patentability. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. Apparatus claims cover what a device is, not what a device does. A claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior apparatus teaches all the structural limitations of the claims. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d, 1429, 1431-2 (Fed. Cir. 1997); Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990); Ex parte Masham, 2 USPQ 2d 1647 (Bd. Pat. App. & Inter. 1987).

Response to Arguments

6. Applicant's arguments filed 3/25/2011 have been fully considered but they are not persuasive.

Applicant's argument that the statement in the prior office action regarding the common technical feature implies immediate patentability does not persuade the examiner because the examiner is unaware of any such practice as outlined in the MPEP or any case law. Common technical features are different than Special technical features and the common technical feature of the instant invention is known in the prior art as demonstrated by the rejections above.

Applicant's argument that Beer's notch 46 is not a perforation does not persuade the examiner because Beer's notch 46 clearly falls within the scope of the broadest reasonable interpretation of the term perforation, "a hole made by piercing, ulceration, etc." (Webster's New World College Dictionary 2010). The applicant's argument that the nominal label differences is patentable does not persuade the examiner where the combination of references in the rejection above meets the broadest reasonable interpretation of the claim terms.

Applicant's argument that the Beer/Warr combination fails to teach the shape changing perforations as claimed because 21a and 21b are the same shape does not persuade the examiner because the notch 23 of Warr is a perforation as well, see above.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized

that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

For the reasons stated above, as well as those set forth in the rejections above, the examiner is not persuaded and the rejections are maintained.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PETER HELVEY whose telephone number is (571)270-1423. The examiner can normally be reached on M-Th 8:00 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. H./
Examiner, Art Unit 3782

June 3, 2011

/NATHAN J NEWHOUSE/
Supervisory Patent Examiner, Art Unit 3782